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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/508,487	03/10/00	BERGSTROM	454312-3150

020999

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HM12/0920

EXAMINER

SWARTZ, R

ART UNIT

PAPER NUMBER

1645

9

DATE MAILED: 09/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.  
**09/508,487**

Applicant(s)  
**Bergstrom**

Examiner  
**Rodney P. Swartz, Ph.D.**

Art Unit  
**1645**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-72 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-72 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### **Election/Restrictions**

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

- |           |   |
|-----------|---|
| Group I   | Claims 1-19, 36-49, 53, 54, 58, 60, 65, drawn to DNA, vector, transformed cell, method of making peptide. |
| Group II  | Claims 20-35, 50-52, 55-57, 59, 61, 65, 67-70, drawn to polypeptide and method of immunizing.             |
| Group III | Claims 62, 71, drawn to method of detecting antibodies.   |
| Group IV  | Claims 63,64, drawn to method of DNA hybridization.   |
| Group V   | Claims 66, 72, drawn to method of making protein vaccine.   |

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of Group I and IV is DNA, Group II, III, and V is polypeptide,

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Groups I and IV are different combinations of different categories of claims. Under Rule 13, in addition to an independent claim for a given product (the DNA of the instant case) an applicant is entitled to an independent claim for a use of the said product. In the instant case, the first claim for a use is a method of making a peptide, while a second use, Group IV is a method of DNA hybridization (M.P.E.P. §1850).

Groups II, III, and V are different combinations of different categories of claims. Under Rule 13, in addition to an independent claim for a given product (the peptide of the instant case) an applicant is entitled to an independent claim for a use of the said product. In the instant case, the first claim for a use is a method of making an immunization using the peptide, while a second use, Group III is a method of immunoassay, and a third use is a method of formulating a vaccine (M.P.E.P. §1850).

While the International Preliminary Examination Report is considered by the Examiner during the prosecution of the U.S. application, the Examiner is not restricted to the decisions of the International Preliminary Examination Report. Therefore, because of the divergent nature of claims of Inventions I-V, the restriction is deemed proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

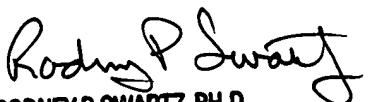
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., whose telephone number is (703)

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308-4244. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (703)308-3909. The facsimile telephone number for the Art Unit Group is (703)308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703)308-0196.

  
RODNEY P. SWARTZ, PH.D.  
PRIMARY EXAMINER  
Art Unit 1645

September 19, 2001